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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,748	02/28/2002	Paul K. Wolber	10020405-1	8764

7590 10/03/2005

AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
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EXAMINER

ZHOU, SHUBO

ART UNIT PAPER NUMBER

1631

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/086,748

Applicant(s)

WOLBER ET AL.

Examiner

Shubo (Joe) Zhou

Art Unit

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-8 and 10-12.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

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Continuation of 3(a). NOTE: The amendment to claim 1 to read on "and a set of features containing probes that hybridize to specific target molecules under stringent conditions" in lines 7-8 and "entire set" in line 12-13, amendment to claim 10 to read on "and each normalized signal intensity being functionally related to a mole fraction of sample molecules that hybridize to the respective feature" in lines 12-13, and new claims 15-16 will require new consideration and search.

Continuation of 11:

In regard to rejection of claims 1 and 7-8 under 35 U.S.C. 102(b) as being anticipated by Lockhart et al. (IDS document: WO 97/10365, 3/20/1997), applicants' argument is on the ground that the amended claim 1 including a newly added limitation "entire set" would overcome the rejection. Since the amendment has not been entered for reasons set forth above, the newly added limitation is not considered. The claims stand rejected for reasons of record.

In regard to the rejection of claims 1-3, 5, and 7-8, and 10-12 under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (WO 97/10365, 3/20/1997), in view of Chenchik et al. (US patent no. 6,077,673, Date of Patent: June 20, 2000) and further in view of Lewin, B., (Genes IV, 1990, Oxford University Press), applicants' argument is on the ground that Lockhart et al. do not calculate the total intensity of all the PM and MM probes, but only those that incremented NPOS or NNEG. This is not persuasive because claim 1 recites calculating a collective signal intensity from the signal intensities read from the set of calibrating features, and in Lockhart et al., the set of probes that incremented NPOS or NNEG is the set of calibrating probes because their intensities are factored in the calibration. And it is the total intensities of these probes that are calculated. Claims stand rejected.

In regard to rejection of claims 1, 4, 7-8, and 10-12 under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (WO 97/10365, 3/20/1997), in view of Chenchik et al. (US patent no. 6,077,673, Date of Patent: June 20, 2000) and further in view of Darnell et al. (Molecular Cell Biology, Eds., 1990, published by Scientific American Books), applicants' argument is on the same ground as that for the rejection of immediately above, the argument is not found persuasive for the same reasons as set forth above.

In regard to rejection of claims 1, 6-8, and 10-12 under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (WO 97/10365, 3/20/1997), in view of Chenchik et al. (US patent no. 6,077,673, Date of Patent: June 20, 2000) and further in view of Feinberg et al. (Analytical Biochemistry, Vol. 132, pages 6-13, 1983), applicants do not argue against the rejection, but rather assert that newly added claims 15 and 16 would be allowable. This is not persuasive because new claims 15-16 are not entered and are not considered. Claims 1, 6-8, and 10-12 stand rejected.

AS

*John S. Brusca* 28 September 2001  
JOHN S. BRUSCA, PH.D  
PRIMARY EXAMINER